THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte STEVEN L. EDWARDS
and MICHAEL J. SMITH

_____

Appeal No. 1997-1291
Application 08/283,934[1]

_____

ON BRIEF

_____

Before DOWNEY, JOHN D. SMITH and OWENS, Administrative Patent Judges.

DOWNEY, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-10, all the claims pending in the application.

[1] Application for patent filed August 1, 1994.

The subject matter on appeal is directed to a method of applying a debonder (softener or lubricant) to a tissue surface.

Claim 1 is illustrative and reads as follows:

1. A method of applying a debonder to a tissue web comprising atomizing an aqueous solution of the debonder, dispersing the atomized debonder solution with steam to form a debonder/steam mixture, and spraying the atomized debonder/steam mixture onto a surface of the tissue web.

The references relied upon by the examiner are:

Smith et al. (Smith)	4,994,144	Feb. 19, 1991
Ampulski et al. (Ampulski)	5,246,545	Sep. 21, 1993

Claims 1-10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ampulski in view of Smith. We reverse.

Ampulski is directed to a method of applying papermaking additives to the surface of tissue paper. The additive may be a polysiloxane debonder (column 17, lines 1-10, and column 18, line 10 et seq.) . The method comprises atomizing a debonder solvent mixture and applying the same to a heated roller. The heat roller evaporates some of the solvent leaving a thin coating, haze or mist containing the additive which is then transferred to the surface of a dried and creped tissue paper by

contacting the dry tissue web with the heated transfer surface. Contrary to appellants' position, Ampulski indicates that when polysiloxane is applied to one surface of the tissue paper, some of it will, generally, at least partially penetrate to the tissue paper interior

(column 18, lines 51-57). Ampulski does not teach the use of steam as an evaporator and a carrier for the atomized debonder solution. Smith teaches the use of steam to impart bulk to dried creped tissues. It is the examiner's position that one of ordinary skill in the art would have found it obvious (1) to replace the heated transfer surface with a steam atmosphere to achieve limited penetration of the softener into the tissue paper and save the expense of the heated rollers and (2) to employ steam in conjunction with the softener to spray the softener onto the tissue paper since Smith teaches that application of steam to a tissue paper imparts an advantageous increase in the bulk of the tissue paper. We disagree.

The Patent and Trademark Office (PTO) has the burden under 35 U.S.C. § 103 of establishing a prima facie case of obviousness. In re Piasecki, 745 Fed.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). In determining the propriety of the PTO case for obviousness in the first instance, it is necessary to ascertain whether or not the reference(s) teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination or modification. In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

On this record we find that the examiner has not provided sufficient evidence to establish that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use steam as an evaporator and as a means to transfer a

debonder to a creped and overdried web in the Ampulski process. Ampulski's goal is to use as little water as possible in his process because it can degrade the product causing a loss in crepe and/or tensile strength (column 13, lines 20-24). Ampulski teaches that any water that is added to the paper by his process is less than what would normally be taken up by the atmosphere upon cooling to room temperature (column 13, lines 27-30). Ampulski limits the use of water by applying a dilute aqueous chemical papermaking additive solution on to a hot transfer surface having a temperature below the boiling point of water to evaporate the solvent from the additive solution before transferring the additive to the web (column 14, lines 18-47). Thus, in our view the examiner has not adequately explained why one of ordinary skill in the art would have combined the teachings of Ampulski, whose goal is to avoid or limit water in his process, with the teachings of Smith to employ steam to evaporate and transfer the additive to the web.

REVERSED

MARY F. DOWNEY)
Administrative Patent Judge)
)
)BOARD OF PATENT
JOHN D. SMITH)
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